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PATENT
Attorney Docket No: 27866/34810

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Gray et al.

Application No. 09/509,165

Filed: June 12, 2000

For: "Macrophage Derived Chemokine (MDC), MDC Analogs, MDC Inhibitor Substances, and Uses Thereof"

Group Art Unit: 1648

Examiner: Bao Q. Li

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231 on September 17, 2002.

David A. Gass

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir:

In a communication dated May 17, 2002, the Patent Office alleged that the claims pending in the above-identified application were directed to twelve distinct inventions and required restriction under 35 U.S.C. §121 and 372. Reconsideration is respectfully requested in view of the following remarks.

I. Election

The Applicants hereby elect Group VII (claims 26 and 30-31), "drawn to a method of palliating an allergic reaction in a mammalian subject." (Office Action at p. 3.)

II. Traversal of Restriction

A. The Basis for Restriction Was Improper

The Office action divided the current application into twelve inventive groups. The Office Action alleged that the claims did not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lacked the same or corresponding special technical features. The Applicants respectfully traverse the restriction for the reasons outlined below.

The Office Action stated that the special technical feature of the claimed invention is drawn to a purified polypeptide of macrophage derived chemokine. However, the Office Action alleged that this technical feature regarding a chemokine derived from the macrophage had been taught in the prior art. The Office Action cited Vicari et al. (Immunity 1997, vol. 7, pp. 291-301) and Schaniel et al. (J. Exp. Med. 1998, vol. 188, pp. 451-463).

Neither the Vicari nor the Schaniel reference is prior art to the present invention. Accordingly, the polypeptide of Macrophage Derived Chemokine is not taught in the prior art and may serve as a common, special technical feature linking all claims of the present application. Consequently, the restriction requirement should be withdrawn, and the claims should be examined as a whole.

While Vicari reports a chemokine derived from macrophages, it does not teach the Macrophage Derived Chemokine that is a common feature of the present claims. The Macrophage Derived Chemokine of the present invention refers to a particular chemokine, one member of which is the human MDC of SEQ 10 NO:2, as well as certain analogs and homologues from various mammalian species, that is derived from macrophages. Vicari does not teach the Macrophage Derived Chemokine of the present invention, and does not destroy unity of invention.

Schaniel is not prior art, because the present PCT application claims priority at least as early as September 26, 1997, the filing date of 08/939,107, as stated on p. 1, lines 5-6 of the specification, whereas Schaniel was not published until August 3, 1998. SEQ ID NOS: 35 and 36 of the present application correspond to murine MDC cDNA and amino acid sequences respectfully, and are discussed on p. 97 lines 13-14 (and elsewhere) in the present application, and p. 91 lines 13-14 (and elsewhere) of 08/939,107. While the murine MDC reported by Schaniel does appear to have substantial homology to the murine MDC of the present application, Schaniel's publication date (August 3, 1998) of nearly one year *after* the relevant priority application, 08/939,107 (September 26, 1997), means that Schaniel is *not* prior art. Accordingly, Schaniel neither anticipates nor makes obvious the Macrophage Derived Chemokine of the present application, and does not impact unity of the invention.

Neither Vicari nor Schaniel anticipate or make obvious the Macrophage Derived Chemokine of the present application. As a result, Macrophage

Derived Chemokine can serve as a common, special technical feature unifying all claims of the present invention. Accordingly, the Applicants submit that the Office action's restriction of the claims should be withdrawn, and that all claims should be examined as a single group.

B. Groups VII Through X Share Additional Common, Special Technical Features

Groups VII through X of the present application share the additional special technical feature of using an MDC antagonist to treat particular conditions in a mammal. Accordingly claims 26-31 should be grouped together, even if the Patent Office maintains its restriction of the other groups.

CONCLUSION

For the reasons set forth above, the Applicants respectfully request examination of Groups I-XII, and request prompt and favorable consideration on the merits.

Respectfully submitted,

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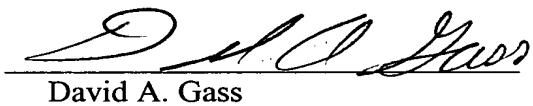
By: 
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September 17, 2002